

REMARKS

Claims 1 – 11 and 13 – 46 are pending in the instant patent application.

Independent claim 44 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Wolfberg (U.S. Patent No. 5,214,579). Specifically, the Office Action asserts that col. 9, lines 1 – 10 and 21 – 26 anticipates claim 44.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). See also MPEP §2131.

Applicant respectfully submits that Wolfberg does not teach each and every element of claim 44 and in particular does not teach “automatically increasing the total difference by a reserve factor.” Col. 9, lines 21-26 of Wolfberg teaches drawing funds from company’s profit and put the funds into the accounts to place the account growth rate back to a growth target. In other words, inputting the funds will reduce or remove the total deficit or difference between the account performance and the target performance and will certainly not increase the total difference.

Applicant therefore respectfully requests that the rejection of claim 44 under 35 U.S.C. § 102(b) be withdrawn because Wolfberg does not teach each and every element of claim 44.

Claims 1, 4-5, 27-29, 32-40, 45-46 have been rejected under 35 U.S.C. § 103 as being unpatentable over Anonymous (Asset allocation programs: “A partnership between operations and investments”) in view of Wolfberg.

Applicant respectfully traverses these rejection of the claims under 35 U.S.C. §103 for the following reasons.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. 2143.03 citing *In re*

Royka, 490 F.2d 981 (CCPA 1974). A finding of obviousness under 35 U.S.C. § 103(a) requires a determination that the differences between the claimed subject matter and the prior art are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. Graham v. Deere, 383 U.S. 1 (1966). The relevant inquiry is whether the prior art suggests the invention and whether the prior art provides one of ordinary skill in the art with a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be found in the prior art. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

As for combination of prior art, applicants respectfully submit that in holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention. See, e.g., Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376 (Fed. Cir. 2001). Moreover, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification. See, e.g. In Re Frich, 972, F.2d 1260 (Fed. Cir. 1992).

In rejecting claim 1, the Office Action asserts that page 3, lines 28 – 35 of Anonymous teaches “determining a pattern of investments to meet the preselected guaranteed amount” and “applying the diversification guideline to the information file to determine whether the information file meets the guidelines.”

Applicant submits that page 3, lines 28-35 of Anonymous does not teach “determining a pattern of investments to meet the preselected guaranteed amount.” That portion of Anonymous apparently teaches that automated systems can more easily track deviation ranges and it is in no way related to determining a pattern of investments.

Furthermore, regarding the combination of Anonymous and Wolfberg, applicant respectfully submitted that the Office Action did not provide any prior art that contains suggestion, motivation, or teaching that would have led a person of ordinary skill in the

art to select the references and combine them in the way that would produce the claimed invention. The Office Action only stated that it would be obvious to someone skilled in the ordinary art at the time of the invention to combine Anonymous and Wolfberg. Applicants respectfully submitted that this statement alone does not make the modification obvious unless the prior art suggests the desirability of the modification. In Re Frich.

Applicants therefore respectfully requests that the rejections against independent claim 1 be withdrawn. Applicant further requests that rejections against claims 4 – 5, which depend on claim 1, be withdrawn for at least the same reasons.

In rejecting independent claim 27, the Office Action admits that Wolfberg does not disclose “selecting one from the plurality of monthly charges that produces zero value for the probability and distribution produced.” The Office Action asserts that it “would be possible by simply selecting the appropriate value from the plurality of charges and could easily be accomplished in the Wolfberg method.”

Applicant respectfully submits that whether a reference could possibly perform a limitation of the claimed invention is irrelevant to making a *prima facie* case of obviousness. The reference must teach or suggest the claimed limitation. Wolfberg is completely silent, as the Office Action admits, regarding the plurality of monthly charges. The only teaching or suggestion for “selecting one from the plurality of monthly charges” comes from the Applicant’s own specification and appears to be improper hindsight reconstruction.

Moreover, applicant respectfully submits that the Office Action did not provide any prior art that contains suggestion, motivation, or teaching that would have led a person of ordinary skill in the art to select the references and combine Anonymous and Wolfberg in the way that would produce the claimed invention. The Office Action only stated that it would be obvious to someone skilled in the ordinary art at the time of the invention to combine Anonymous and Wolfberg. Applicant respectfully submits that this statement alone does not make the modification obvious unless the prior art suggests the desirability of the modification. In Re Frich.

Applicant submits that claim 27 is allowable and requests the withdrawal of the rejection against independent claim 27 and claims 28 – 29, which depend on claim 27.

In rejecting independent claim 32, the Office Action asserts that Anonymous, at page 3, lines 21-27, teaches “determining whether diversification guidelines are met for the plurality of funds and the plurality of transactions.” Applicant respectfully submits that Anonymous does not teach the claimed limitation but instead describes the process of executing trades. Anonymous does not teach or suggest “determining whether diversification guidelines are met for the plurality of funds and the plurality of transactions” but merely argues why automated asset allocation programs are desirable.

Also, the Office Action simply stated that it would be obvious to someone skilled in the ordinary art at the time of the invention to combine Anonymous and Wolfberg but did not provide any such suggestion or teaching from any prior art. Applicant therefore requests the withdrawal of the rejection against claim 32 for at least the reason above. Applicant further requests the withdrawal of the rejection against claims 33-34 for the same reason for claim 32 and for the additional reason below.

In rejecting dependent claim 33, the Office Action asserts that Anonymous, at page 3, lines 21-35, teaches “if the plurality of funds and plurality of transactions does not meet the diversification guidelines, providing to the client a timetable to reallocate the plurality of funds; and determining whether diversification guidelines are met for the reallocated plurality of funds.” Applicant respectfully submits that Anonymous does not teach the claimed limitation but instead describes the process of executing trades and argues that automated systems can more easily track deviations in individual accounts.

In rejecting dependent claim 34, the Office Action admits that Anonymous and Wolfberg do not explicitly disclose “if the total contributions exceed a predetermined amount, automatically generating a report to the client requesting the excess of contributions over the predetermined amount be withdrawn; automatically generating a timetable for the client to withdraw the excess of contributions over the predetermined amount; if the timetable is not met, automatically identifying a fund from the plurality of

funds containing the largest amount; automatically opening a second account with the fund from the plurality of funds containing the largest amount; and automatically transferring the excess of contributions over the predetermined amount from the fund from the plurality of funds containing the largest amount to the second account." The Office Action then takes official notice that these steps were well known in the art.

Applicant agrees that accounts such as Roth IRA's have, by law, maximum annual contributions that cannot be exceeded. But Applicant respectfully traverses the official notice because the teachings of claim 34 are not disclosed or suggested by the art at the time of the invention. Especially, there is no teaching or suggestion at the time of the invention to "automatically generating a time table" for withdrawing excessive funds and to automatically transfer the excess funds from the funds containing the largest amount to a second account.

In rejecting independent claim 35, the Office Action asserts that Anonymous, at page 3, lines 21-27, teaches "inputting user specific data." Applicant respectfully submits that Anonymous does not teach the claimed limitation but instead describes the process of executing trades repeatedly and distributing proceeds to all client accounts.

Further, Applicant respectfully submitted that the Office Action did not provide any prior art that contains suggestion, motivation, or teaching that would have led a person of ordinary skill in the art to select the references and combine Anonymous and Wolfberg in the way that would produce the invention claimed in claim 35. The Office Action only stated that it would be obvious to someone skilled in the ordinary art at the time of the invention to combine Anonymous and Wolfberg. Applicant respectfully submits that this statement alone does not make the modification obvious unless the prior art suggests the desirability of the modification. In Re Frich.

Applicant also respectfully requests the withdrawal of the rejects on dependant claims 36-40 for the same reason for claim 35.

Further, with respect to claim 37, applicant agrees that accounts such as Roth IRA's have, by law, maximum annual contributions that cannot be exceeded. But

Applicant again respectfully traverses the official notice because the teachings of claim 37 are not disclosed or suggested by the art at the time of the invention. Especially, there is no teaching or suggestion at the time of the invention to "automatically generating a time table" for withdrawing excessive funds and to automatically transfer the excess funds from the funds containing the largest amount to a second account.

Claims 2-3 and 30-31 have been rejected under 35 U.S.C. § 103 as being unpatentable over Anonymous in view of Wolfberg, and further in view of Lane.

Applicant respectfully traverses these rejection of the claims under 35 U.S.C. §103 for the following reasons.

First, applicant's arguments traversing the rejection on independent claim 1 also apply to claims 2-3 because these claims depends on claim 1. Second, The Office Action only stated that it would be obvious to someone skilled in the ordinary art at the time of the invention to combine Anonymous, Wolfberg and Lane. Applicants respectfully submitted that this statement alone does not make the modification obvious because the prior art did not suggest the desirability of the modification. In Re Frich. Therefore, it would not be proper to reject claims 2-3 and 30-31 based on the combination of Wolfberg and Lane. Further, Wolfberg in col. 3, lines 25-34 only teaches that a fund may become unavailable if its growth rate is lower than 8%. It did not teach or suggest automatically determining the date of the unavailability, or automatically determining the value of the unavailable fund.

Claims 6, 9, 13-14, 16-17 and 45-48 are rejected under 35 USC § 103 as being unpatentable over Wolfberg in view of Anonymous, and further in view of Edesess.

Applicant respectfully traverses these rejection of the claims under 35 U.S.C. §103 for the following reasons.

First, the Office Action only stated that it would be obvious to someone skilled in the ordinary art at the time of the invention to combine Anonymous, Wolfberg and Edesess. Applicants respectfully submitted that this statement alone does not make the modification obvious because the prior art did not suggest the desirability of the

modification. In Re Frich. Therefore, it would not be proper to reject claims 6, 9, 13-14, 16-17 and 45-48 based on the combination of Wolfberg, Anonymous and Edesess.

Further, Regarding claim 6, Anonymous at page 3 only teaches why manual or partly automated systems cannot handle the large volume of transactions of periodic rebalancing. It did not teach or suggest (1) automatically searching predetermined probability distribution functions; (2) automatically listing a plurality of funds by projected accumulation investment amount; (3) comparing a diversification guideline to the plurality of funds, or (4) automatically combining a plurality of funds meeting the diversification guideline.

Regarding claim 9, Wolfberg in col. 1, lines 55-60 only teaches tracking and interpreting the growth of initial investments using periodic projections. It did not teach or suggest inputting initial and periodic contributions. The same applies to claims 13-14 and 16-17 because they depend on claim 9.

Regarding claim 13, Wolfburg in col 1, lines 60-67 and col. 9, lines 26-30 only teaches in addition to initial investment and monthly update processing, the system also handles client requests for service, such as a check or credit card purchase. It did not teach or suggest automatically presenting completed projections if the user interrupts the step of automatically performing a projection of the accumulated amount.

Regarding claim 17, Anonymous did not disclose or suggest setting a yield equal to the index performance for a predetermined number of simulations. The Office Action's statement that this feature is obvious is not proper in view of the case law (In Re Frich). Further, Anonymous did not teach or suggest automatically performing a distribution model for the number of simulations greater than the predetermined number.

Regarding claims 45 and 46, Wolfburg did not disclose or suggest discounting the accumulated investment amount by a reserve interest rate. Again, the Office Action's statement that this feature is obvious is not proper in view of the case law (In Re Frich) because none of the references provided suggests that.

Claims 7-8, 10-11, 15, 18-21, 23-26 and 41-43 are rejected under 35 USC § 103 as being unpatentable over Wolfberg in view of Anonymous, in view of Edesess and further in view of Lane.

Applicant respectfully traverses these rejection of the claims under 35 U.S.C. §103 for the following reasons.

First, the Office Action only stated that it would be obvious to someone skilled in the ordinary art at the time of the invention to combine Anonymous, Wolfberg, Lane and Edesess. Applicants respectfully submitted that this statement alone does not make the modification obvious because the prior art did not suggest the desirability of the modification. In Re Frich. Therefore, it would not be proper to reject claims 7-8, 10-11, 15, 18-21, 23-26 and 41-43 based on the combination of Wolfberg, Anonymous, Lane and Edesess.

Further, regarding claims 7-8, the same argument of claim 6 applies here because claims 7-8 depend on claim 6.

Regarding claim claims 10-11, the same argument of claim 9 applies here because claims 10-11 depend on claim 9.

Regarding claim 15, Lane in Table 2 only discloses anticipations of interest rates (see page 103, lines 5-7), not projected yield. Neither did Lane disclose in Table 2 average projected yield.

Regarding claims 18, Anonymous only teaches the benefit of automatic asset balancing. No where is Anonymous disclose automatic performing a distribution model to generate multiple accumulation amounts.

Regarding claims 19 and 20, Lane did not teach or suggest automatically calculating the average projected yield. Instead, Lane only discloses calculating anticipated interest rates.

Regarding claim 21, Lane in table 4 did not teach or suggest a method including an averaged yield. Neither did Lane in Table teach or suggest a probability that the average yield will exceed the projected yield in any year.

Regarding claim 23, the Office Action's statement that it would have been obvious to use an index fund in the plurality of funds is not proper in view of case law (In Re Frich) because none of the references provided suggests that.

Regarding claim 24, the Office Action's statement that it would have been obvious to use an annuity calculator is not proper in view of case law (In Re Frich) because none of the references provided suggests that. The same argument also applies to the rejection on claim 25.

Regarding claim 26, it is first respectfully submitted that Lane did not teach, disclose, or suggest comparing the fixed income retirement amount paid to an amount payable using an annuity; and if the fixed income retirement amount paid is less than the amount payable using the annuity, paying the difference to the user. Therefore, the combination of Wolfburg, Anonymous, Edeseee and Lane did not teach each and every limitation of claim 26. Secondly, the Office Action's statement that it would have been obvious to someone skilled in the art at the time of the invention to include Lane's fixed income steps is not proper in view of case law (In Re Frich) because none of the references provided suggests that. The same arguments also apply to claims 41-43.

Claim 22 is rejected under 35 USC § 103 as being unpatentable over Wolfberg in view of Anonymous, in view of Edesess and further in view of Lewellen.

Applicant respectfully traverses this rejection under 35 U.S.C. §103 because the references provided by the Office Action provide no suggestion to combine Wolfburg, Anonymous, Edesess and Lewellen. Therefore, such a rejection is not proper in view of case law. (In Re Frich).

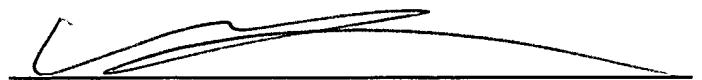
Applicant respectfully requests entry of the foregoing amendments and remarks into the file history of the above-identified application. Applicant believes that each ground for rejection has been successfully overcome and/or obviated, and that all

pending claims are in condition for allowance. Withdrawal of the rejections and allowance of the application are respectfully requested.

No additional fee is believed to be due in connection with filing of the instant request. However, if an additional fee is due, please charge the required fee to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310.

Respectfully submitted,

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